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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,249	12/10/1999	MIKE CHANG	M-7970-US	3399

24251 7590 05/22/2002

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EXAMINER

RAO, SHRINIVAS H

ART UNIT PAPER NUMBER

2814

DATE MAILED: 05/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/468,249

Applicant(s)

CHANG ET AL.

Examiner

Steven H. Rao

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Priority**

Receipt is acknowledged of paper submitted under 35 U.S.C. 120, which papers have been placed of record in the file.

### **Continued Prosecution Application**

The request filed on 3/27/2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/468249 is acceptable and a CPA has been established on April 04, 2002 . An action on the CPA follows.

### **Preliminary Amendment Status**

Acknowledgment is made of entry of preliminary amendment filed 3 /27/ 02 which has been entered on April 04, 2002.

Therefore claim 1 as amended by the preliminary amendment and presently newly added claim 9 and claims 2-8 as previously recited are currently pending in the application.

Claims are examined by examiner as best understood.

### **Claim Rejections - 35 USC § 112**

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9 the phrase "wherein the portion of the one lead of the lead frame that is co planar with the second side of the die extends laterally to be coplanar " renders the claim indefinite because the term "wherein the portion of the one lead of the lead frame that is co planar with the second side of the die extends laterally to be coplanar " is not clear. It is not clear what applicants mean by extending coplanar extending in reference to what element and coplanar with what element.

Further the specification, prosecution history, prior art and one skilled in the art do not indicate as to what specific activity is covered by the recited language.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Publication No. 9-64421 (herein after Yamada-I) and Japanese Patent Publication no. 6-177429 (herein after Yamada – II) both previously applied.

With respect to claim 1, Yamada I and II substantially describe all of the recited features as previously stated in the office actions and incorporated herein by reference.

The newly added limitation, "and the at least one lead being in electrical contact with the second electrical terminal (Yamada – I fig.1 the lead from element 5 is in electrical contact with element (second electrical terminal) 2).

Applicants' alleged that claims 2-8 were allowable because they depend upon allegedly allowable claim 1.

However as shown above claim 1 is not allowable therefore claims 2-8 (claims 3-8 are rejected over Yamada-I, II and Umemoto) are also not allowable.

With respect to claim 9, to the extent understood, wherein the portion of the one lead of the lead frame that is coplanar with the second side of the die extends laterally to be coplanar (Yamada fig. 1 lead from 5 extends laterally towards 7 (above 2) with which it is coplanar in a portion).

### **Response to Arguments**

Applicant's arguments filed 3/27/02 have been fully considered but they are not persuasive because :

Applicants' argue that the lead in Jp-9 (sic. 6)-177429 contacting terminal 7 is not coplanar with the top surface.

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However the claim1 recites, " at least one lead frame containing a portion that is coplanar with the second side of the die' ( emphasis supplied). ( i.e.any portion of the lead wire and not specifically the upper portion)

As pointed out in the O/A mailed 6/20/01 page 2 the above limitation is meet by Yamada Fig.1 lead end out of 5 i.e. the beginning of the lead wire above 5 is coplanar with 7 that is above 2).

It is noted that the argued limitation " the upper lead wire is not coplanar " is not recited the claim and need not be given patenable weight.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steven H. Rao whose telephone number is (703) 306-5945. The examiner can normally be reached on Monday- Friday from approximately 7:00 a.m. to 5:30 p.m.


Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956. The Group facsimile number is (703) 308-7722.



Steven H. Rao

Patent Examiner

May 18, 2002.



JEROME JACKSON  
PRIMARY EXAMINER  
GROUP 2500